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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,082	07/30/2001	Gregory Merle Pineo	60,680-531	2107

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EXAMINER

CIRIC, LJILJANA V

ART UNIT PAPER NUMBER

3753

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,082

Applicant(s)

PINEO ET AL.

Examiner

Ljiljana (Lil) V. Ciric

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004 and on 10 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-13, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 14, 15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 9, 2004 has been entered.

Response to Amendment

2. This Office action is in response to the amendment and arguments filed on June 10, 2004.

3. The amendment filed on June 10, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: that the actuator portion of the valve housing has no inlet and outlet openings for flow through the actuator portion, particularly as relating to the elected species/embodiment depicted in Figures 1 through 4.

Applicant is required to cancel the added new matter from paragraphs [0005] and [0006] as well as from base claims 1 and 14 in the reply to this Office Action.

4. Claims 1 through 6, 8 through 15, and 17 through 20 remain in this application, all as amended, either directly or indirectly. Of these, claims 8 through 13, 19, and 20 remain withdrawn from further consideration as noted in greater detail below.

Response to Arguments

5. Applicant's arguments filed on June 10, 2004 have been fully considered but they are not persuasive, as follows.

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Applicant notes, for example, that claims 1 and 14 have been amended to add the limitation “the actuator portion having no inlet and outlet openings for flow through the actuator portion”, further arguing that “support in the disclosure for these amendments may be found in the drawings and in paragraph [0030] where it is stated that inlet and outlet openings in *all* embodiments are formed in the plug portion 26.” Applicant then further notes that the “amendments to paragraphs [0005] and [0006] of the disclosure are to make the Summary of the Invention correspond with the amended independent claims.” Nevertheless, there is NO support in Figures 1 through 4 corresponding to the elected first species for there being NO inlet and outlet openings for flow through the actuator portion”; on the contrary, as previously noted in the Advisory Action mailed on August 2, 2004, Figures 3 and 4 corresponding to the elected species clearly show inlet and outlet openings 60 as being disposed in the actuator portion 48 of the valve housing. Paragraph [0030] referred to by the applicant describes *the non-elected species corresponding to the embodiment of Figure 9*, and states that “inlet and outlet openings 44, 46 are formed in opposed plug walls 114, 116, and *this shows that inlet and outlet openings 44, 46 can be located anywhere in plug portion 26* as long as one of these openings is blocked when valve 112 is closed”; there is NO mention of actuator portion inlet and outlet openings 60 in paragraph [0030]. Thus, not only does paragraph [0030] NOT in any way mention or describe there being or there not being actuator portion inlet and outlet openings 60, paragraph [0030] is NOT clearly applicable to either all species or to the elected species corresponding to the embodiment of Figures 1 through 4. Applicant also cannot subsequently amend the specification in order to provide support for new material NOT claimed in the application as originally filed. Thus, applicant’s arguments regarding there being sufficient support for the amendments to the claims and the specification are NOT persuasive, and the examiner maintains the holding of new matter previously identified by the examiner via the Advisory Action mailed on August 2, 2004.

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With regard to the new matter issue discussed above, it is also hereby also noted by the examiner that it is the general policy of the Office NOT to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter, as is the case in the instant application. Applicant further cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right.). And, even though the examiner is acting on the claims as amended (which may be considered as drawn to a non-elected invention), since the inventions are distinct, an election is NOT waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943). See MPEP § 819.

Otherwise, applicant's arguments with respect to the *Seiler et al.* reference failing to anticipate claims 1 through 6, 14, 17, and 18 have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendments to the claims.

Election/Restriction

6. Claims 8 through 13, 19, and 20 hereby remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected , there being no allowable generic or linking claim. Election was made without traverse in Paper No. 8.

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, there being NO inlet and outlet openings for flow through the actuator in the actuator portion of the housing as newly recited in the claims must be shown in the Figures 1 through 4 corresponding to the elected species or the feature(s) canceled from the claim(s). No new matter should be entered. [NOTE: It is strongly recommended that the aforementioned features

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be canceled from the claims since changing Figures 1 through 4 to incorporate the claimed subject matter would constitute new matter.]

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

8. As already noted above, the amendment filed on June 10, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: that the actuator portion of the valve housing has no inlet and outlet openings for flow through the actuator portion as now specified in paragraphs [0005] and [0006], particularly as relating to the elected species/embodiment depicted in Figures 1 through 4.

Applicant is required to cancel the added new matter in the reply to this Office Action.

Claim Rejections - 35 U.S.C. § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1 through 6, 14, 15, 17, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, base claims 1 and 14 (which are supposed to be readable on the elected species corresponding to Figures 1 through 4], as well as all claims depending therefrom, now newly recite the limitations "the actuator housing having no inlet and outlet openings for flow through the actuator portion". There is no support in the originally filed disclosure for the elected species corresponding to Figures 1 through 4 for there being NO inlet and outlet openings for flow through the actuator portion of the valve housing. On the contrary, as previously noted, Figures 3 and 4 corresponding to the elected species *clearly* show both inlet and outlet openings 60 as being disposed in the actuator portion 48 of the valve housing. The added limitations thus represent new matter relative to the elected species corresponding to Figures 1 through 4.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 6, 14, 15, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There appears to be insufficient antecedent basis for the newly added limitations "said bypass valve inlet and outlet openings" [claim 6, lines 2-3; claim 14, line 12]. Furthermore, it is not clear whether or not in each case these limitations refer back to the limitations "with opposed plug walls defining *inlet and outlet openings in said plug walls*" [claim 1, lines 4-5; claim 14, lines 4-5]. If so, recommend replacing the limitations "said bypass valve inlet and outlet openings" with one of the limitations "said

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plug wall portion inlet and outlet openings” or “said plug wall inlet and outlet openings” or “said inlet and outlet openings in said plug walls”, as appropriate.

Claim Rejections - 35 U.S.C. § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1 through 6, 14, 15, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by *Schaefer* (previously of record).

Schaefer discloses a bypass valve fluidly or operably connected to a heat exchanger essentially as claimed, including, for example: a heat exchanger 15 as shown in Figure 1 or as shown in Figure 2 having a plurality of tubular members or heat exchange conduits or oil flow passages 55 having spaced-apart wall portions defining openings for the flow of fluid through the tubular members or passages 55; a bypass valve 21 or 72; a valve housing 13 or 62 defining a hollow plug portion corresponding to the housing portion encompassing the “opposed” walls and inlet/outlet structures including ports or openings 54, 56, and 58, the latter readable (in various combinations) on the bypass valve inlet opening 10 or 19 or 68 or 69 and outlet opening 11 or 63 as recited in the claims of the instant application [see column 6, lines 3-41]; and, an actuator portion enclosed by cap 31 or 74 and located adjacent to the plug portion, the actuator or cap portion having no inlet or outlet openings for flow through the actuator portion; an actuator comprising a central shaft or member 35 releasably mounted in the cap or actuator portion 31 or 74, the actuator comprising central shaft or member 35 including/operably connected to a reciprocating plunger in turn comprising pins 50 and 46 and boot 52 which extend into the plug portion of the valve 21 or 72 to form a “reciprocating barrel portion”; and, enlarged distal end portions of the plate pairs of the heat exchanger joined together to form adjacent inlet and outlet manifolds 58 and 59 as shown in figure 2;

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the housing actuator portion including a removable closure or cap 31 or 74 located remote from the plug portion, the actuator central shaft or member 35 being attached to the removable closure or cap 31 or 74; and biasing means including springs 23 and/or 37. The actuator comprising central shaft or member 35 in combination with pins 50 and 46, boot 52, and expansible heat sensitive or thermal material 53 make up a thermal motor which extends axially upon being heated to a predetermined temperature and which retracts upon being cooled below the predetermined temperature [see column 4, lines 42 through 68; also, column 5, lines 1-9].

The reference thus reads on the claims.

Conclusion

15. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buchanan, Caroli, and Buchanan et al. all disclose valves without flow passages for the regulated fluid through the corresponding actuator portions of the valves.


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (571) 272-4909.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene, can be reached at (571) 272-4930.

lvc

December 2, 2004


LJILJANA V. CIRIC
PRIMARY EXAMINER
ART UNIT 3753